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Richard M. Saccocio
Richard M. Saccocio, P.A.
100 Southeast 12th Street
Ft. Lauderdale, FL 33316

EXAMINER

DURAN, ARTHUR D

ART UNIT

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3622

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Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 3622



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/910,654
Filing Date: July 20, 2001
Appellant(s): BURROWS, RODGER

MAILED

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GROUP 3600

Richard M. Saccocio
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 11/25/2005 appealing from the Office action mailed 5/24/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A previous appeal before this Board was had in Appeal No. 2004-21 10. There are no other related appeals and interferences.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

Industry Agent's handbook (IAH), Section 70.0 (2000 Ed.)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARC references submitted by the Applicant.

Claims 1-15, 17, and 18: The Board of Patent Appeals and Interferences (BPAI) Decision dated January 25, 2005 presented the following rejection of these claims as being obvious over the ARC references:

"We reject Claims 1-15, 17, and 18 under 35 U.S.C. 103(a) as being unpatentable over the prior art submitted by the appellant which has collectively been labeled ARC. We incorporate the finding made by the examiner in rejecting these claims under 35 U.S.C. 102(f) except for the finding that ARC discloses the electronic storage of coupon data. Even though we found above that ARC does not disclose the electronic storage of coupon data as asserted by the examiner, we agree with the examiner's position that the storage of coupon data electronically would have been obvious to the artisan in view of the teachings in ARC that coupon data should be stored in optical form. At the time this application was filed, it was well known in the art to store image data in electronic form so that it could be transmitted over a communications channel such as a facsimile transmission or a multimedia network transmission. Thus, although ARC in its entirety seems to suggest an optical storage of image data, the artisan would have found it obvious to also store the image data in electronic form for subsequent reconstruction of the image."

The Examiner adds that as cited by the Applicant in the Response in Exhibits 1 and 2 (the 2000 IAH and 2005 IAH references) "ARC stated ... all supporting documents must be copied to microfiche/film or to a non-magnetic optical medium that uses 'write once, read only' technology which will prevent overwriting ... However, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media are NOT acceptable. (emphasis in the original)". This passage teaches one of ordinary skill in the art (i.e. artisan) that the supporting documents (including the agent coupon) could be stored on microfiche, microfilm, non-magnetic optical medium, computer hard drives, zip drives, floppy disks, magnetic tape, and other magnetic media, but that such storage would not be acceptable to the ARC, except for the first three. This clearly discloses that alternate means for storing the supporting documents were not only known at the time, but also considered by the ARC. Whether or not the ARC would accept storage of the agent coupon data on a certain type of storage media does not remove the teaching of such by the above passage. The rules and regulations are subject to change by the ARC at any time. The requirement to store an agent coupon may be eliminated altogether in the future, additional forms may be added to the required storage list, or a new type of storage medium may be developed and accepted by the ARC in the future. However, none of these possibilities would remove the obviousness of storing the agent coupon data (or any other documents or forms) on the various types of storage mediums available at the time.

(10) Response to Argument

The Applicant argues that ARC only disclosed the storage of an optical image of the agent coupon and not electronic storage of agent coupon data.

Examiner notes that the Board of Patent Appeals and Interferences (BPAI) decision mailed on January 25, 2005 on page 4 and thereafter has already fully recognized the arguments that the Appellant is making in this Appeal Brief dated November 25, 2005. The following is quoted from the BPAI decision affirming the Examiner which was mailed on January 25, 2005 on page 4, "Appellant argues that independent claims 1 and 15 recite the storage of agent coupon data electronically whereas ARC only describes the storage of agent coupon data as an actual image of the agent coupons. Appellant argues that there are several. . ."

Also, Examiner notes that the BPAI decision states on page 11, "We make the following new ground of rejection using our authority under 37 CFR 5 41.50(b). We reject claims 1-15, 17 and 18 under 35 U.S.C. 5 103(a) as being unpatentable over the prior art submitted by appellant which has collectively been labeled ARC."

Hence, the BPAI has already recognized the Appellant's arguments and the BPAI has already presented a 35 USC 103 rejection addressing the Appellant's arguments and the features of the Appellant's claims. The Examiner agrees with the BPAI 35 USC 103 rejection and has presented it above as was presented in the Final Rejection dated 5/24/2005.

The Examiner further notes that in the passages from the 2000 IAH and 2005 IAH references cited by the Applicant in the Response, the ARC discloses that the agent may "maintain the required documents on microfiche film or on an optical storage medium"... "which will prevent overwriting" (emphasis added). This citation does not state that an optical image of the agent coupon is being stored, only that the required documents (which would include the agent coupon) may be stored on an optical storage medium that cannot be overwritten. Such optical storage media known at the time were CDs, DVDs, WORM disks, etc. Many of these

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devices would have met the write-once, read only criteria of the ARC. For example, the Microsoft Computer Dictionary, Third Edition, printed in 1997, defines "compact disc" as "An optical storage medium for digital data" and when defining "compact disc - erasable" states "Contemporary CDs are 'write once, read many', in that the information originally written cannot be changed, but can only be appended to." (page 104). Thus, as the rejection in the BPAI Decision concluded, it would have been obvious to an artisan at that time to store the agent coupon and the other supporting documents as digital data on an optical storage medium such as a CD.

Examiner further notes that Appellant's own specification (2002/0091554) discloses that data can include image format data:

"[16] ...FIG. 1 illustrates one embodiment of the apparatus and method of the present invention. ...The data 13 to be stored can be transmitted for example, in image format, accounting record format, or data file format. The data 13 can be transmitted to the storage apparatus 15 at the time each airline ticket 12 is created. . .

Claim 1: . . .storing said agent coupon data in a director/directory/image file arrangement; and retrieving said electronically stored agent coupon data and printing the same. . .".

Also, Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664

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(Fed. Cir. 2000). Appellant's claims disclose minimal features concerning what the coupon data does or does not consist of in terms of content or in form.

Also, the Applicant's argument that the invention achieved the same goal as the ARC but not by using the same method disclosed or suggested by the ARC is not persuasive. As discussed above, the ARC discloses various types of storage medium upon which the supporting documents could be stored, but placed a caveat on what criteria had to be met by the storage medium before it would be accepted to the ARC, namely that the storage medium could not be overwritten. The Examiner notes that in Claim 3 the Applicant is claiming that the storage medium used in the invention is a hard drive, one of the storage mediums explicitly mentioned (suggested) by the ARC. Thus, the invention is achieving the same goal as the ARC and using a method at least suggested by the ARC.

The Applicant's argument that the ARC disclosures teach away from the Applicant's claimed invention is not persuasive. As discussed above, the passages cited by the Applicant explicitly teach various types of storage mediums upon which the data could be stored, but then select the ones which the ARC finds acceptable (e.g. ones that cannot be overwritten). A reference which teaches a plurality of alternatives does not teach away from a disclosed alternative by selecting a different alternative as the preferred embodiment.

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Hence, the Appellant has not added any new features to the claims and the BPAI decision and rejection presented on January 25, 2005 still renders obvious the features of the Appellant's claims.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Arthur Duran', written in a cursive style.

Arthur Duran
Primary Examiner

February 7, 2006

Conferees:

Eric Stamber

Jeff Carlson

Handwritten initials in black ink, likely representing Eric Stamber and Jeff Carlson, positioned to the right of their names.